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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,078	09/22/2003	Kazuma Goto	501152.20021	1248

7590

05/08/2006

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EXAMINER

FAISON, VERONICA F

ART UNIT

PAPER NUMBER

1755

DATE MAILED: 05/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/668,078

Applicant(s)

GOTO ET AL.

Examiner

Veronica F. Faison

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-12 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

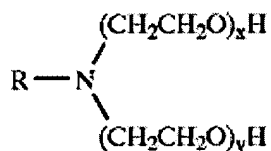
DETAILED ACTION***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koga et al (US Patent 6,758,889) in view of Momose (US Patent 6,749,675).

Koga et al teach ink composition comprising water, a coloring agent, a water-soluble organic solvent, and a compound represented by following general formula (1):



wherein R represents an alkyl group having a number of carbons of 8 to 18, and x+y is not more than 10. The compound may be present in the amount of 0.01 to 5 percent by weight (col. 5 lines 38-46). The reference further teaches a surface tension of the ink is controlled to 31 to 35 mN/m, which can reduce color bleed and feathering (abstract and col. 2 lines 27). The coloring agent may be dyes and pigments, wherein the pigment may also be a surface treatment, which may make the pigment self-dispersing (col. 3 lines 18-36). The surfactant that is present in the ink composition may be an anionic surfactant (col. 3 lines 60-65) and may be present in the amount of 0.01 to 20 percent

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by weight (col. 3 line 66-col. 4 line 3). The reference fails to teach the specific compound taught by formula 1.

Momose teach an aqueous ink composition at least colorant, water, and 0.005 to 10 percent by weight of at least one acetylene alcohol compound (abstract and col. 2 lines 5-22). The reference teach anionic surfactant of formula below



wherein R_{15} is represents a C_{1-15} alkyl group and M_2 may be an alkali metal (col. 2 lines 43-54). The reference further teaches that the formula above may be sodium polyoxyethylene oleyl ether sulfate, which may be used in a composition comprising a surface-modified pigment (Table 8).

Therefore it would have been obvious to one of ordinary skill in the art to use the anionic surfactant sodium polyoxyethylene oleyl ether sulfate as taught by Momose in the ink composition of Koga et al, as Koga et al broadly discloses anionic surfactants, because Momose teaches that sodium polyoxyethylene oleyl ether sulfate may be used in combination with a nonionic surfactant and self-dispersing pigment that produces an ink composition similar to that taught by Koga et al.

Response to Arguments

Applicant's arguments, filed 1-4-06, with respect to JP 10-140065 have been fully considered and are persuasive. The rejection of claims 1, 5-8, 11 and 12 has been withdrawn.

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Applicant's arguments filed 1-4-06 have been fully considered but they are not persuasive.

Applicant argues that In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Koga et al teaches that an anionic surfactant and it would have been obvious to one of ordinary skill in the art to use the anionic surfactant such as sodium polyoxyethylene alkyl ether sulfate, because they are well known anionic surfactant in the art. The use of conventional materials to perform their known functions in a conventional process is obvious. *In re Raner* 134 USPQ 343 (CCPA 1962).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., any relationship between formula (I) and the coloring agent) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

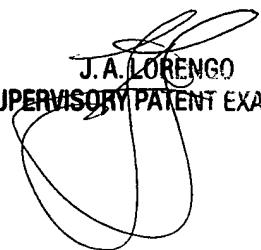
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Veronica F. Faison whose telephone number is 571-272-1366. The examiner can normally be reached on Monday-Thursday and alternate Fridays 8 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

vfg
4-25-06


J.A. LORENCO
SUPERVISORY PATENT EXAMINER